REMARKS

This amendment is submitted in response to the non-final Office Action mailed December 10, 2007 ("Office Action"). After entry of this amendment, claims 35-46, 49, and 51-57 will be pending. Claims 35 and 52 are independent. In the Office Action, the Examiner:

- rejected claims 35-45, 49, and 51-52 under 35 U.S.C. § 102(e) ("Section 102(e)") as anticipated by U.S. Pat. No. 6,264,650 to Ellis et al. ("Ellis"); and
- rejected claims 35-46, 49, and 51-52 under Section 102(e) as unpatentable over Negus et al. ("Negus").

Claim 35 has been amended to recite that "the at least one marking effector is separate from the at least one therapeutic substance delivery effector . . . ." Similarly, independent claim 52 has been amended to recite that "the at least one marking effector is separate from . . . the at least one therapeutic substance delivery effector . . . ." Support for these amendments is found, inter alia, at page 13, lines 3-22 of the specification as filed.

Claims 40 and 41 have been amended for formal reasons.

Claims 53-57 have been added.

New claim 53 depends from claim 52 and recites that "the elongate shaft comprises an endoscope." Support for this amendment is found, inter alia, at page 6, lines 19-23 of the specification as filed.

New claim 54 depends from claim 52 and recites that "the at least one injury effector has a first exposed length and the at least one therapeutic-substance delivery effector has a second exposed length, and wherein the first exposed length is greater than the second exposed length." Support for this amendment is found, inter alia, in Fig. 3 of the specification as filed.

New claim 55 depends from claim 52 and recites that "the third tissue location is different from the first tissue location and the second tissue location." New claim 56 depends from claim 52 and recites that "the at least one therapeutic substance delivery effector and the at least one marking effector are capable of being sequentially actuated by a control structure." New claim 57 depends from claim 52 and recites that "the at least one injury effector and the at least one therapeutic substance delivery effector are capable of being sequentially actuated by a control structure." Support for these amendments is found, inter

alia, at page 13, lines 3-22 of the specification as filed.

No new matter has been added.

Rejection Under Section 102(e) Based On Ellis

Claims 35-45, 49, and 51-52 are rejected under Section 102(e) as anticipated by Ellis. Applicants respectfully request that this rejection be withdrawn.

Independent claims 35 recites that "the at least one marking effector is separate from the at least one therapeutic substance delivery effector . . . ." Similarly, independent claim 52 recites that "the at least one marking effector is separate from . . . the at least one therapeutic substance delivery effector." Ellis does not disclose, teach, or suggest a "marking effector . . . separate from . . . [a] therapeutic substance delivery effector." Instead, Ellis discloses a single infusion lumen that may be used for injecting a contrast fluid and/or a drug. (*See* Figs. 2-8; col. 5, lines 63-67 and Fig. 9.) Therefore, Ellis does not disclose, teach, or suggest each and every element of independent claims 35 and 52, and the rejection of independent claims 35 and 52 based on Ellis should be withdrawn for at least this reason. The rejection based on Ellis of dependent claims 36-45, 49, and 51, which depend from claim 35, should be withdrawn for at least the same reason that the rejection of independent claim 35 should be withdrawn.

Claim 43 depends from claim 35 and further recites that "the elongate shaft comprises an endoscope." Ellis does not disclose, teach, or suggest that its device includes an endoscope. Instead, Ellis teaches the use of fluoroscopy to locate the contrast media infused by its device. (Col. 6, lines 56-65.) If the device of Ellis had an endoscope, there would be no need to use fluoroscopy. Therefore, the rejection of claim 43 based on Ellis should be withdrawn for at least this additional reason.

Claim 45 depends from claim 35 and further recites that "at least one injury effector has a first exposed length and the at least one therapeutic-substance delivery effector has a second exposed length, and . . . the first exposed length is greater than the second exposed length." Ellis does not disclose, teach, or suggest such an injury effector and delivery effector. Figs. 4-5 of Ellis are the only figures that show a delivery effector having any exposed length at all, and, as seen in Figs. 4-5, any exposed length of the electrodes is less than the exposed length of the delivery effector. Therefore, the rejection of claim 45 based on Ellis should be withdrawn for at least this additional reason.

Claim 49 depends from claim 35 and further recites that "the third tissue location [marking location] is different from . . . the second tissue location [therapeutic-substance-delivery location]." Ellis does not disclose, teach, or a suggest a marking location different from a therapeutic-substance-delivery location. To the extent Ellis discloses having both a contrast media and a drug, Ellis discloses having a single fluid contain both the contrast media and the drug. (*See* col. 5, lines 66-67 ("[The] fluid can be saline, contrast media, a drug or any combination of these.").) When this fluid is infused into tissue, the location of the contrast media will be the same as the location of the drug. Therefore, the rejection of claim 49 based on Ellis should be withdrawn for at least this additional reason.

Rejection Under Section 102(e) Based On Negus

Claims 35-46, 49, and 51-52 are rejected under Section 102(e) as anticipated by Negus. This rejection is respectfully transversed.

Independent claims 35 and 52 recite that the lumen is configured to receive the therapeutic substance and "at least a portion of the at least one injury effector passes through, and is electrically isolated from, the portion of the lumen configured to receive the therapeutic substance." Negus does not disclose, teach, or suggest a lumen configured to receive a therapeutic substance wherein an "injury effector passes through . . . the portion of the lumen configured to receive the therapeutic substance." Instead, in Negus, the treatment catheter (that causes ablation) is entirely separate from the agent delivery catheter. Indeed, the treatment catheter and agent catheter in Negus are parallel to one another. At no point does the treatment catheter pass through the agent delivery catheter. (*See*, *e.g.*, treatment catheter 14 and delivery catheter 16 of Figs. 3-6; treatment catheter 14 and delivery catheter 208 of Fig. 10A.) Because Negus does not disclose, teach, or suggest an injury effector passing through a lumen configured to receive a therapeutic substance, Negus does not disclose, teach, or suggest each and every element of independent claims 35 and 52. Thus, the rejection of independent claims 35 and 52 based on Negus should be withdrawn for at least this reason. The rejection based on Negus of dependent claims 36-46, 49, and 51, which depend from claim 35, should be withdrawn for at least the same reason that the rejection of independent claim 35 should be withdrawn.

Claim 43 depends from claim 35 and further recites that "the elongate shaft comprises an endoscope." Negus does not disclose, teach, or suggest that its device comprises an endoscope. Instead, Negus teaches the use of fluoroscopy to locate the channels marked by

its device. (Col. 5, lines 29-34; *see also* col. 8, lines 10-11 (referring to an "external imaging device positioned outside of [the] patient").) If the device of Negus had an endoscope, there would be no need to use fluoroscopy or any other external imaging device. Therefore, the rejection of claim 43 based on Negus should be withdrawn for at least this additional reason.

Claim 46 depends from claim 35 and further recites that "a plurality of therapeutic-substance delivery effectors are disposed radially around at least one injury effector." Negus does not disclose, teach, or suggest a plurality of therapeutic-substance delivery effectors. Instead, Negus teaches only a single agent-delivery catheter, such as agent-delivery catheter 208 in Figs. 9A, 10A, 16, and 17. Therefore, the rejection of claim 46 should be withdrawn for at least this additional reason.

New Claims 53-56

Dependent claims 53-57 have been added. These claims depend from independent claim 52 and therefore are patentable over Ellis and Negus for at least the same reasons that independent claim 52 is patentably over Ellis and Negus.

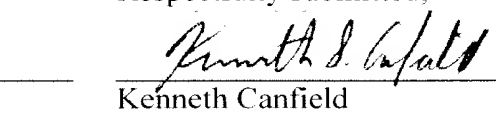
CONCLUSION

It is believed that claims 35-46, 49, and 51-57 are in condition for allowance. Should the Examiner not agree with any of Applicants' positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

No fee is believed due for this response. Should any fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

Respectfully submitted,

Date: March 5, 2008



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